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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,449	08/10/2000	Kimiya Yamaashi	NIP189	6477

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EXAMINER
RAMOS FELICIANO, ELISEO

ART UNIT	PAPER NUMBER
2681	11

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/635,449	YAMAASHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Eliseo Ramos-Feliciano	2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

#### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 November 2003 and 04 December 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-16,25 and 26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

### ***Title***

1. Previous objection to the title of the invention is withdrawn in view of applicant's amendment filed on November 6, 2003.

### ***Abstract***

2. Previous objection to the abstract of the disclosure is withdrawn in view of applicant's amendment filed on November 6, 2003.

### ***Claim Objections***

3. Previous objection to the claims is withdrawn in view of applicant's amendment filed on November 6, 2003.

### ***Claim Rejections - 35 USC § 112***

4. Previous 35 USC 112 – 2nd rejection to the claims is withdrawn in view of applicant's amendment filed on November 6, 2003 and December 4, 2003.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-16 and 25-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollenberg (US Patent Number 6,091,956) in view of Alten et al. (US Patent Number 5,781,246).

Regarding **claim 1**, Hollenberg discloses a digital broadcasting system that includes a digital broadcasting transmission apparatus (elements 14 and 32; Figures 1, 3, 5) for broadcasting data groups (elements 3 and 29; Figures 2, 4, 6, 11, and 12) and a digital broadcasting receive apparatus (elements 18 and 19; Figures 1, 3, 5) (device 2; Figures 2, 4, 6, 11) for receiving the data groups directly or indirectly through a data distribution part (elements 30 and 36; Figures 1, 3, 5). See column 21, line 30 to column 23, line 8; column 11, lines 23-26, column 12, lines 1-5, and column 18, lines 40 & 61, *inter alia*.

The digital information (data groups) originates from a global communications network (element 31; Figures 1, 3, 5) that includes "services such as electronic mail, entertainment, games, news, television, particularly digital TV, and access to other networks, including the Internet, for example" (column 7, lines 41-46; emphasis added).

The digital broadcasting transmission apparatus has a transmission means (e.g. 32) for multiplexing and broadcasting ordinary data (e.g. digital information described above) and index data defined as identification of data broadcast already or to be broadcast in future, as depicted in the display (4) the broadcasting receive apparatus (2) exhibited in Figures 2, 4, 6, 11 and as illustrated in Figure 12. See column 21, line 30 to column 22, line 42.

The ordinary data are presently on broadcast, while identification data and index data is multiplexed thereon to compose digitally-broadcast data. The index data being broadcast repeatedly (in real time). As depicted in Figure 11, elements 8i, 6w and 6x.

However, Hollenberg fails to specifically disclose discriminating between data already broadcast and data to be broadcast, and further relating identification data with broadcasting hours.

Nevertheless, Hollenberg teaches that the broadcast data can be "particularly digital TV", as recited above. Consequently, Hollenberg's digital broadcasting receive apparatus may include a digital TV receiver.

In the same field of endeavor, Alten et al. discloses a digital broadcasting system that includes a digital broadcasting receive apparatus or digital TV receiver with on screen "TV guide"; see the abstract. As depicted in Figure 20 of Alten, the composed digitally-broadcast data includes identification data and index data. The identification data permit to discriminate between data already broadcast (for example at 4:30p) and data to be broadcast in the future (for example at 8:00p). The index data relates the identification data with broadcasting hours; notice present time is 6:50pm (element 183). The rest of Alten et al.'s figures contain many other examples of these features.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to complement Hollenberg's digital broadcasting receive apparatus with Alten et al.'s teachings, such as TV guide, because it facilitates the marketing and sale of programs and services; provides the user with flexible and uncomplicated on-screen interface; and provides user with current programming information, *inter alia*, as taught by Alten et al., see column 4, lines 31-42.

Regarding claims 2-8, Hollenberg and Alten et al. disclose everything claimed as applied above (see *claim 1*). In addition, "the item's symbol, icon, or name is capable of being included with other items in a executably selectable menu which appears to pop up, that is, to quickly graphically appear adjacent to the icon or text item which was executably selected by the user, on the user's computer display, whether it is to be included in the map displayed on user's

computer, and, if displayed, whether the item's symbol, which may be a standard display symbol which is resident in memory, including storage, on user's device, or the item name can be subsequently selected by a user to automatically provide additional information about the item, such as by enlarging the detail, called zooming in, or, for example, as hypertext, in which the item name or symbol can be selected or clicked on by a user to provide additional information. Data type 29d also includes executable code for animated icons or avatars (graphic elements which represent their users in such a display). Concise code such as mappable code 29 is particularly suited to low bandwidth information communication systems such as those which might be found in large areas. After connection with the local information service provider, the user's location and look ahead request, initiated by selecting look ahead icon 8f in FIG. 6, are communicated to the service provider which responds by sending the appropriate information. Device 2g receives mappable hypertext code for each item to be represented on the display, such as items 3m, 3n, 3p, 3q, and main roads" (column 22, lines 16-42). See also column 25, lines 13-31.

From above, the index data includes a data ID and a remote location from which the data can be downloaded (e.g. URL / address). See column 21, line 30 to column 22, line 42; and Figure 12. Distinctive identifiers are added to the ordinary data and the index data.

As to the digital broadcasting receive apparatus, data separation means are inherent in view of the fact that data is transmitted differently as explained above. As to judge means, reference is made to Figure 2, 4, 6, and 11. As the user travels from one location to another, the data being displayed is updated from an original data to an updated data; this process inherently

includes judge means as claimed. See the abstract, and column 21, line 30 to column 23, line 8, *inter alia*. See also column 25, lines 13-31.

As illustrated by Figures 1, 3, and 5 the digital broadcasting receive apparatus is a mobile terminal (e.g. 18, 19), and includes download request means for allowing to select (click) the necessity for downloading by displaying index data (hypertext) of an original data not downloaded yet (additional information): "as hypertext, in which the item name or symbol can be selected or clicked on by a user to provide additional information" (column 22, lines 28-30). The mobile terminal further includes both transmission means for transmitting the download request and receive means for receiving the contents in response thereto. An ID and password (public-key) for uniquely identifying the requesting terminal is used for the purpose of receiving back the additional information; see column 23, line 24, *inter alia*.

Regarding **claims 9-12 and 25-26**, Hollenberg and Alten et al. disclose everything claimed as applied above (see *claims 1-3*). In addition, the digital broadcasting receiver may be characterized as an information relay apparatus or information service station. It includes a data receive means for receiving the digital broadcasting contents, and a data memory means for storing the received data groups; see column 20, line 57, column 22, lines 34-44, and column 27, lines 51-59. See also the rejection of *claims 2-8* above which is incorporated herein.

Regarding **claim 13**, Hollenberg discloses a mobile terminal (2; 18, 19) embedding a computer executing plural installed software programs such as map navigation, as depicted in Figures 1-6 and 10-11. The mobile terminal (2) includes communication means (14) for receiving digital broadcasting contents, input means (e.g. touch-screen 4a-4d) for accepting an operation input by a user: "hypertext, in which the item name or symbol can be selected or

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clicked on by a user to provide additional information" (column 22, lines 28-30). The mobile terminal (2) also includes information memory means for storing programs and related data, display means (4) for displaying an execution result of programs and a operation screen; and control means (controller) for managing a program data captured from the communication means and the input means. The information memory means stores management information including information ID of the programs and independent data; see Figure 12; abstract; column 7, lines 41-46, column 12, lines 13-40 column 18, lines 20-67, column 19, lines 9-14, column 20, lines 54-60, column 21, line 29 to column 23, line 40, and column 25, lines 10-30.

The mobile terminal receives time division multiplex data (see GSM; column 5, line 41). Ordinary data originates from a global communications network (element 31; Figures 1, 3, 5) that includes "services such as electronic mail, entertainment, games, news, television, particularly digital TV, and access to other networks, including the Internet, for example" (column 7, lines 41-46; emphasis added).

The ordinary data are presently on broadcast, while identification data and index data is multiplexed thereon to compose digitally-broadcast data. The index data being broadcast repeatedly (in real time). As depicted in Figure 11, elements 8i, 6w and 6x.

However, Hollenberg fails to specifically disclose discriminating between data already broadcast and data to be broadcast, and further relating identification data with broadcasting hours.

Nevertheless, Hollenberg teaches that the broadcast data can be "particularly digital TV", as recited above. Consequently, Hollenberg's digital broadcasting receive apparatus may include a digital TV receiver.

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In the same field of endeavor, Alten et al. discloses a digital broadcasting system that includes a digital broadcasting receive apparatus or digital TV receiver with on screen "TV guide"; see the abstract. As depicted in Figure 20 of Alten, the composed digitally-broadcast data includes identification data and index data. The identification data permit to discriminate between data already broadcast (for example at 4:30p) and data to be broadcast in the future (for example at 8:00p). The index data relates the identification data with broadcasting hours; notice present time is 6:50pm (element 183). The rest of Alten et al.'s figures contain many other examples of these features.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to complement Hollenberg's digital broadcasting receive apparatus with Alten et al.'s teachings, such as TV guide, because it facilitates the marketing and sale of programs and services; provides the user with flexible and uncomplicated on-screen interface; and provides user with current programming information, *inter alia*, as taught by Alten et al., see column 4, lines 31-42.

Regarding **claim 14**, Hollenberg and Alten et al. disclose everything claimed as applied above (see *claim 13*). In addition, the mobile terminal's control means receives the broadcast multiplexed data. The data includes several components, such as those depicted in Figure 12, including an ID (number or name). The "user selects which of an optional plurality of visit lists to begin downloading" (column 25, lines 13-15). "Mappable hypertext items, may be executably selected by user to provide additional information or execute as computer code" (column 13, lines 36-38). The "hypertext, in which the item name or symbol can be selected or clicked on by a user to provide additional information" (column 22, lines 28-30). The communication means

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has a receive channel corresponding to a transmission from a download requester as well as a receive channel for the digital broadcasting.

Regarding **claims 15-16**, Hollenberg and Alten et al. disclose everything claimed as applied above (see *claim 13*). However, Hollenberg and Alten et al. fail to particularly disclose an "IC card" or an "external memory media to be inserted" as claimed by applicant.

The examiner contends that an "external memory media" for storing downloaded information, as well as related information (identification indicia, such as, user number), is conventionally known in the art for the well known advantage of saving memory space in the subject device, or for expanding the capability of storage of the subject device.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to particularly enable Hollenberg and Alten et al.'s mobile terminal with the capability of an external memory media for storing downloaded information for the advantage of expanding the capability of storage of the subject device, or for saving memory space in the subject device.

#### *Response to Arguments*

7. Applicant's arguments with respect to *claims 1-16* have been considered but are moot in view of the new ground(s) of rejection.

#### *Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any response to this Office action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to: (703) 872-9306

for formal communications intended for entry, informal communications or draft communications; in the case of informal or draft communications, please label "PROPOSED" or "DRAFT".

Hand-delivered responses should be brought to

Crystal Park II

2121 Crystal Drive

Arlington, VA

Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is (703) 305-0078. The examiner can normally be reached on Monday through Thursday (first week of bi-week) and Monday through Friday (second week of bi-week) from 8:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh H. Tran, can be reached on (703) 305-4040.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700, or call Group customer service at (703) 306-0377.



SINH TRAN  
PRIMARY EXAMINER

ELISEO RAMOS-FELICIANO  
PATENT EXAMINER

ERF/erf

February 22, 2004.